

**REMARKS**

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111, and in light of the remarks which follow, are respectfully requested.

Claims 8, 9, 12 and 13 have been rewritten in independent form. Claims 1-5 were previously canceled.

No new matter has been added. Upon entry of the Amendment, claims 6-17 will be all the claims pending in the application.

**I. Response to Double Patenting Rejections**

a. Claims 6 and 7 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claim 1 of U.S. Patent Application No. 10/545,202.

While not conceding the propriety of this rejection, Applicants submit herewith a Terminal Disclaimer to expedite prosecution. The filing of a Terminal Disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

In view of the above, the Examiner is respectfully requested to reconsider and withdraw the nonstatutory obviousness-type double patenting rejection.

b. Claims 6 and 7 were rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 2 of U.S. Patent No. 6,905,521. Applicants respectfully traverse the rejection for the following reasons.

Independent claim 6 recites a hair color comprising 0.5 to 8 % by weight of a *basic dye* as a coloring agent, 0.5 to 15 % by weight of *an alcohol-soluble acryl base resin*, 20 to 80 % by weight of a lower alcohol and 5 to 50 % by weight of water.

The presently claimed hair color can provide unexpectedly superior results in terms of a cumulative hair dyeing property, such as water resistance and a temporary coloring property, compared to a composition using an acidic dye. Moreover, as described at page 2, 3rd paragraph of the present specification, a hair dyeing composition containing an acidic dye also dyes the skin of the scalp and the fingertips. In contrast, a composition containing a basic dye recited in present claim 6 does not dye the skin. These effects are further demonstrated in the examples of the present specification (Examples 1-5 vs. Comparative Examples 1-4 in Table 1). In particular, Comparative Example 1, which did not contain an alcohol-soluble acryl base resin, was inferior in terms of cumulative hair dyeing property and water resistance. Comparative Example 2, which contained a conventional acidic dye, caused skin dyeing. Comparative Example 3, which contained an alcohol-soluble acryl base resin in an amount exceeding the recited range of 0.5 to 15% by weight, showed inhibited cumulative hair dyeing property. Comparative Example 4, which contained a basic dye in an amount exceeding the recited range of 0.5 to 8% by weight, was inferior in terms of water resistance and skin dying property.

Under 35 U.S.C. § 103(a), the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. M.P.E.P. § 2142. In addition, “[t]he key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit

has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval)." M.P.E.P. § 2142.

In the present case, the Office Action has hailed to establish that the features recited in claim 6 is obvious over claims 1 and 2 of the '521 patent. Specifically, independent claim 1 of the '521 patent recites a cumulative hair-dyeing composition comprising 0.01 to 3% by weight of *an acid dye* as a colorant, 0.1 to 10% by weight of *a nonionic or anionic silicone base resin*, 3 to 20% by weight of a hair-dyeing aid, 30 to 80% by weight of a lower alcohol and 5 to 50% by weight of water, wherein an inorganic pigment is not contained and said composition has a pH of 2 to 5 and a viscosity of 100 mPa·s or less.

The Office Action merely concluded that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to formulate such a coloring composition by optimizing the coloring ingredients in the composition in order to get the maximum effective amounts of these ingredients in the composition and would expect such a composition to have similar properties to those claimed, absent unexpected results" (page 3, 2nd paragraph). The Office Action has failed to establish a *prima facie* case of obviousness by providing any reasons why it would have been obvious to modify the cumulative hair dyeing composition recited in claim 1 of the '521 patent by, *inter alia*, substituting a *basic dye* for the *acidic dye* as a coloring agent, and *an alcohol-soluble acryl base resin* for the *nonionic or anionic silicone base resin*.

Furthermore, as set forth above, unlike a composition containing an acidic dye, a hair color containing a basic dye recited in present claim 6 does not dye the skin. Claims 1 and 2 of the '521 patent do not disclose or suggest this feature of the presently claimed hair color.

In view of the foregoing, Applicants respectfully submit that present claim 6 is patentable over claim 1 of the '521 patent. Additionally, present claim 7 depends from claim 6 and thus is patentable over claims 1 and 2 of the '521 patent.

## II. Response to Rejection under 35 U.S.C. § 103(a)

Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2003/0066142 ("Tsuchiya") in view of U.S. Patent Application Publication No. 2002/0046431 ("Laurent"). Applicants respectfully traverse the rejection for the following reasons.

As a preliminary matter, Applicants note that U.S. Patent Application Publication No. 2003/0066142 is the application publication of U.S. Patent No. 6,905,521, which is patent document 1 (172141/2001 A1) cited at page 3 of the present specification, which corresponds to Japanese Patent Application No. 11/357891.

Under 35 U.S.C. § 103(a), rationales for combination of references include simple substitution of one known element for another to obtain predictable results, use of known technique to improve similar devices in the same way, applying a known technique to a known device ready for improvement to yield predictable results, choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success, known work in one field that prompts variations of it for use in either the same field or a different field based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill and some teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine

prior art reference teaching to arrive at the claimed invention. The Official Action must also show that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function. M.P.E.P. § 2141.III.

In the present case, the Office Action has failed to establish that the features recited in claim 6 is obvious over Tsuchiya in view of Laurent.

Specifically, Tsuchiya discloses a hair dyeing composition comprising an acidic dye, a nonionic or anionic silicone base resin, a hair dyeing aid, a lower alcohol and water.

Laurent discloses a composition widely used for a permanent or semi-permanent hair color, which comprises an oxidation dye for dyeing, an amphiphilic polymer comprising at least one fatty chain, an oxyalkylenated or glycerolated fatty alcohol, a hydroxylated solvent, and optionally a direct dye. Laurent generally describes representative dyes, which have been conventionally used in direct dyeing compositions, including conventional neutral, cationic and anionic direct dyes. As discussed above, these direct dyes can be used in conjunction with an oxidation dye in Laurent.

Laurent does not provide any evidence showing that conventional neutral, cationic and anionic direct dyes would provide the same or similar results in other hair dyeing composition, such as that described in Tsuchiya, not containing an oxidation dye. Moreover, in Laurent, the composition is applied by a complicated and troublesome operation, and even a ready-to-use composition is prepared at the time of use (paragraph [0477]). On the other hand, the hair color of Tsuchiya is applied with an applicator which can simply be used by a user. As such, there would have been no predictable results by substituting an anionic direct dye described in Laurent for the acidic dye in the composition of Tsuchiya. Therefore, it would not have been obvious to combine Laurent with Tsuchiya.

Furthermore, as discussed above, the presently claimed hair color can provide unexpected results in terms of a cumulative hair dyeing property, such as water resistance and a temporary coloring property, and skin dyeing property. Neither Tsuchiya nor Laurent discloses or suggests these effects.

In view of the foregoing, Applicants respectfully submit that claim 6 is patentable over Tsuchiya in view of Laurent and thus the rejection should be withdrawn. Additionally, claim 7 depends from claim 6 and is thus patentable over the cited references at least by virtue of its dependency.

### **III. Response to Objection to the Claims**

Claims 8-17 were objected to for being dependent upon a rejected claim.

In the Amendment, claims 8, 9, 12 and 13 have been rewritten in independent form. Claims 10, 11, and 14-17 depend from claim 8 or 9. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the objection.

### **IV. Conclusion**

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (202) 452-7932 at his earliest convenience.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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